

REMARKS

The Examiner has rejected claims 1-5 and 22-34 under 35 USC 103(a) as being unpatentable over U.S. 5,954,303 to Wolf, et al. in view of U.S. 2,676,387 to Lindlof.

The Examiner has also objected to claim 25 without comment. Assuming that the Examiner is objecting to the term "particular" appearing in claim 25 in error, the Applicant has amended claim 25 to substitute the term "particles" for "particular". Thus, claim 25 now corresponds to claim 32 originally submitted and no new matter has been added.

With regard to the rejection under 35 USC 103(a) the Examiner alleges that Wolf, et al. discloses a cover (32) that is stretched and can be molded to a stretch contour. The cover prevents leakage and has a backing (16) disposed within the cover there is a core with a volume of separate, open cell foam particulates which are compressible and when a liquid can be partially disposed (through absorption). The Examiner also alleges that there is a gel between the particulates which can enable lubricated movement of the particles with respect to one another in response to an outside force applied to the cover and prevents sensing of the particulates by a user. The Examiner also states that Wolf, et al. discloses that the gel is similar to that used in Lindlof which has an oil in it. The Examiner concludes that while Wolf, et al. does not specifically disclose the exact combination of particulates and gel, however, one of ordinary skill in the art would be able to use the disclosure that the materials could be combined to make a pad which has a core consisting of gel and particulates.

The Applicants submits that as indicated by the underlined emphasis of the Examiner's remarks hereinabove shown, the Examiner is suggesting that it is obvious to try the combination suggested by the Examiner. The Applicant's submits that even if it was obvious to try, it does not follow that the results of such trial would have been anticipated; obvious to try is not the same as obviousness; the test of obviousness is whether the invention as a whole would be obvious, including the nature of the results obtained. Novo Industri A/SV Travenol Laboratories, Inc., et al. 215 USPQ 412 (Court of Appeals 7th Circuit 1982).

The Applicants submits that the Examiner has not made a prima facie case of obviousness under 35 USC 103(a) on the basis of the Wolf, et al. and Lindlof references.

First, the Applicants submits that the Wolf, et al. and Lindlof references are non-enabling disclosures. As certainly they are argued it has been stated that even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it were not enabling. In re Donohue 226 USPQ 619, 621 (CAFC 1985), In re Borst, 45 USPQ 552, 557 (CCPA 1965), Cert. Denied, 148 USPQ 771 (1966).

It is well settled that prior art under 35 USC 102(b) must sufficiently described the claimed invention to have placed the public in possession of it. In re Sasse, 207 USPQ 107, 111 (CCPA 1980); In re Samour, 197 USPQ 4; Redding and Bates Construction Company v. Baker Energy Resources Corp. 223 USPQ 1168-1173 (Fed. Cir. 1984).

Such possession is effected if one of ordinary skill in the artwork could have combined the publication's, description of the invention with his own knowledge to make the claimed invention. In re LeGrice, 133 USPQ 365, 373 (CCPA 1962).

The statement in Wolf that "The support material may also be a combination of these or other suitable materials..." is a mere "germ" of an idea. However, as set forth in Genentech, Inc. v. Novo Nordisk, A/S, 42 USPQ 2d 1001 (Fed. Cir. 1997) an enabling disclosure is not "tossing out the mere germ of an idea" but the provision of "reasonable detail..." in order to enable members of the public to understand and carry out the invention.

Clearly, the Wolf, et al. reference intends to encompass every material in the world which is suitable for supporting wrists of a user and any combination of all materials that exist.

The Applicants submits that for prior art to be pertinent it must be enabling—it must place the public in possession of the invention. Items which do not sufficiently teach and skill artists in how to make, use and practice the invention are not prior art to the invention. Akzo N. V. Vu.S. Int'l Trade Commission 1 USPQ 1241, 1245 (Fed. Cir. 1986); in re Hall, 228 USPQ 453, 455 (Fed. Cir. 1986) further stating that in order to be prior art, the prior art referenced must teach the claimed invention without further research or experimentation. See also in re Pyne 203 USPQ 245, 255 (CCPA 1979) and Fizer, Inc. v. International Rectifier Corp. 207 USPQ 397, 425 (Dist. Ct. C.D. California 1980).

The Applicants submit that the Wolf, et al. reference does not suggest a core comprising a volume of separate particulates in a oil disposed between the particles for enabling lubricated movement of the particles with respect to one another in response to an outside force applied to a cover over the core. (See claim 1)

The Wolf, et al. reference, in addition to listing all possible materials that could be used for supporting the wrist of a user further states that a combination of this infinite number of materials can be utilized depending upon the preference of the manufacturer. This disclosure, if assumed enabling, would anticipate every wrist pad made, or to be made.

The Applicants submits that this disclosure does not place the public in possession of the present invention and does not sufficiently teach a skilled artisan how to make, use and practice the invention. Thus it is not prior art to the invention. Ethyl molded products Co. v. Betts Package, Inc. 9 USPQ 2d 1001, 1030 (E.D. 1988).

The Applicant further argues that the Wolf, et al. reference also would not support a rejection under 35 USC section 103 on the same arguments hereinabove provided.

The Lindlof reference does not teach any particulates and, in fact, the paragraph cited by the Examiner, namely in column 3, beginning with line 64 states:

"A mixture of 5 parts 'Nujol' Brand U.S.P. Mineral oil and one part styrene-isoprene-styrene block equal polymer

("Kraton 107" were heated to approximately 300°F. and agitated vigorously until the polymer appeared virtually dissolved". (Emphasis added)

Accordingly, the Lindof reference has no value whatsoever with regard to anticipating or making obvious claimed the present invention, which includes a core comprising a volume of separate particulates and an oil disposed between the particulates for enabling lubricated movement of the particulates.


In view of the arguments hereinabove set forth it is submitted that each of the claims now in the application define patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is aware of the references of record. Reconsideration and allowance are respectively requested.

Respectfully submitted,



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